

REMARKS

Claims 1 through 14 are extant in the case.

Examiner has rejected claims 1 through 14 under 35 U.S.C. § 102.

Applicant has amended independent claims 1, 8 and 14 to increase clarity.

Rejection under 35 U.S.C. § 102 (b)

Examiner has rejected claims 1 through 14 under 35 U.S.C. § 102 (b) as being anticipated by USPN 6,671,718 (Meister). Applicant respectfully traverses the rejection as to the claims as amended.

Criteria for a Rejection under 35 U.S.C. § 102

The criteria for a rejection under 35 U.S.C. § 102(b) has been clearly defined by the courts and confirmed by the U.S. Patent and Trademark Office. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Examiner has failed to show that each and every element set forth in the claims is found either expressly or inherently in Meister. Based on this, Applicant is traversing the rejections of the claims.

Below, Applicant points out subject matter within each independent claim that is not disclosed by Meister. On the basis of this, Applicant believes all the claims are patentable over Meister.

Independent Claim 1

Claim 1 sets out a method for sending an electronic message. Substep (a.1) sets out that, in preparation for sending an e-mail message, any addresses within a field of the e-mail message used to specify addresses to be removed from the "To" field are removed from any addresses specified in a "To" field of the e-mail message. This is not disclosed or suggested by Meister.

Meister allows a user to manually remove addresses from a "To" field of an e-mail message. See Meister at Figure 6 and column 5, lines 17 through 27. However, Meister does not disclose or suggest the use of a field of the e-mail message used to specify addresses to be removed from the "To" field.

Examiner has argued that in Meister it is inherent the modification operation displays a specified address in a display object such as a dialog box which are known to contain fields. However, claim 1 of the present case is not concerned with the fields used in a dialog box. The use of fields to implement a dialog box does not disclose or suggest a field of an e-mail message used to specify addresses to be removed from the "To" field.

Applicant notes that e-mail messages often contain fields such as "To", "CC", and "BCC". However, the prior art does not disclose or suggest e-mail

messages that contain a field used to specify addresses to be removed from the "To" field. Nothing in Meister discloses or suggests such a field. Claim 1, therefore, is patentable over Meister.

Independent Claim 8

Claim 8 sets out a method for sending an electronic message. Substep (a.1) sets out that, in preparation for sending an e-mail message, any addresses within a field of the e-mail message used to specify addresses to be removed from all fields are removed from any addresses specified in a "To" field, a "Cc" field and a "Bcc" field of the e-mail message. This is not disclosed or suggested by Meister.

Meister allows a user to manually remove addresses from a "To" field, a "Cc" field and a "Bcc" field of an e-mail message. See Meister at Figure 6 and column 5, lines 17 through 27. However, Meister does not disclose or suggest the use of a field of the e-mail message used to specify addresses to be removed from the "To" field, the "Cc" field and the "Bcc" field.

Examiner has argued that in Meister it is inherent the modification operation displays a specified address in a display object such as a dialog box which are known to contain fields. However, claim 8 of the present case is not concerned with the fields used in a dialog box. The use of fields to implement a dialog box does not disclose or suggest a field of an e-mail message used to

specify addresses to be removed from the "To" field, the "Cc" field and the "Bcc" field of an e-mail message.

Applicant notes that e-mail messages often contain fields such as "To", "CC", and "BCC". However, the prior art does not disclose or suggest e-mail messages that contain a field used to specify addresses to be removed from the "To" field, the "Cc" field and the "Bcc" field. Nothing in Meister discloses or suggests such a field. Claim 8, therefore, is patentable over Meister.

Independent Claim 9

Claim 9 sets out an electronic mail system for generating a message for being sent electronically. The message includes a field used to specify addresses to be removed from the "To" field in preparation for sending the message. This is not disclosed or suggested by Meister.

Meister allows a user to manually remove addresses from a "To" field of a message. See Meister at Figure 6 and column 5, lines 17 through 27. However, Meister does not disclose or suggest the use of a field of the message used to specify addresses to be removed from the "To" field.

Examiner has argued that in Meister it is inherent the modification operation displays a specified address in a display object such as a dialog box which are known to contain fields. However, claim 9 of the present case is not concerned with the fields used in a dialog box. The use of fields to implement a

dialog box does not disclose or suggest a field of a message used to specify addresses to be removed from the "To" field.

Applicant notes that messages often contain fields such as "To", "CC", and "BCC". However, the prior art does not disclose or suggest messages that contain a field used to specify addresses to be removed from the "To" field. Nothing in Meister discloses or suggests such a field. Claim 9, therefore, is patentable over Meister.

Independent Claim 14

Claim 14 sets out an electronic mail system for generating a message for being sent electronically. The message includes a field used to specify addresses to be removed from the address fields in preparation for sending the message. This is not disclosed or suggested by Meister.

Meister allows a user to manually remove addresses from all fields of the message. See Meister at Figure 6 and column 5, lines 17 through 27. However, Meister does not disclose or suggest the use of a field of the message used to specify addresses to be removed from the address fields of the message.

Examiner has argued that in Meister it is inherent the modification operation displays a specified address in a display object such as a dialog box which are known to contain fields. However, claim 14 of the present case is not concerned with the fields used in a dialog box. The use of fields to implement a

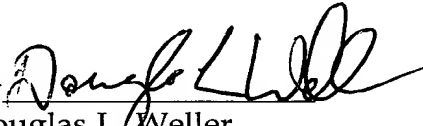
dialog box does not disclose or suggest a field of a message used to specify addresses to be removed from the fields.

Applicant notes that messages often contain fields such as "To", "CC", and "BCC". However, the prior art does not disclose or suggest messages that contain a field used to specify addresses to be removed from the address fields of the message. Nothing in Meister discloses or suggests such a field. Claim 14, therefore, is patentable over Meister.

Conclusion

Applicant believes the Amendment has placed the present case in condition for allowance and favorable action is respectfully requested.

Respectfully submitted,
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